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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,504	04/21/2004	David Epstein	23239-558A (ARC-58A)	7640
30623 7590 05/15/2009 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER SCHNIZER, RICHARD A				
ART UNIT		PAPER NUMBER		
1635				
MAIL DATE		DELIVERY MODE		
05/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,504

Applicant(s)

EPSTEIN ET AL.

Examiner

Richard Schnizer

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

An amendment after final rejection was received and entered on 5/5/09.

Claims 1-3, 7, 8, 10, 13, 17-60 and 64 were canceled.

Claims 11 and 14-16 remain pending.

After further search and consideration, the indication that claims 11 and 14-16 would be allowable if rewritten in independent form is withdrawn. Finality of the previous Action is hereby withdrawn in favor of the following NON-FINAL rejection.

Priority

This application claims priority to US applications 10/718,833, 10/826,077 and provisional applications 60428102, 60469628, 60464239, 60465053, 60474133, 60486580, 60489810, 60503596, and 60523935. See the amendment filed 6/9/2005. None of these applications supports aptamers as claimed comprising an immunostimulatory rCGyy motif. Accordingly the filing date of the instant application is considered to be 4/21/2004.

Claim Objections

Claims 1 and 16 are objected to because of the following informalities: In claim 1 "domains" is misspelled n the penultimate line of the claim.

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 16 is drawn to the composition of claim 14, and indicates that the cytotoxic agent of claim 14 is either used alone or in combination with one of several other agents. Because claim 14 is a composition claim, and not a method claim, the limitations as to how the cytotoxic agent is to be used are not considered to be further limiting.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lupold et al (US 20020119473).

Lupold et taught aptamers to PSMA that comprised the sequences 5'-ACGUU-3' or 5'-UCGAG-3'. Lupold also indicated that the aptamers were useful for the delivery of therapeutic compounds (including, but not limited to, cytotoxic compounds, immune enhancing substances and therapeutic radionuclides) to tissues or organs expressing PSMA. In the preferred embodiment, the therapeutic agent is bonded to the 5' amine of the aptamer. In embodiments in which cancer is the targeted disease, 5-fluorodeoxyuracil or other nucleotide analogs known to be active against tumors can be incorporated internally into existing U's within the PSMA aptamer or can be added

internally or conjugated to either terminus either directly or through a linker. The conjugate may be formulated with a liposome, or a variety of pharmaceutically acceptable carriers. See abstract, Fig. 6; and paragraphs 1, 15, and 70-73. Thus Lupold taught an aptamer with the structure required by the instant claims, and so anticipates the claims.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 571-272-0762. The examiner can normally be reached Monday through Friday between the hours of 6:00 AM and 3:30. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, James (Doug) Schultz, can be reached at (571) 272-0763. The official central fax number is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Richard Schnizer/
Primary Examiner, Art Unit 1635

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